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Wei Yen

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PERKINS COIE LLP

P.O. BOX 2168

MENLO PARK, CA 94026

EXAMINER

BOND, CHRISTOPHER H

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/670,129	<b>Applicant(s)</b> YEN ET AL.	
	<b>Examiner</b> CHRISTOPHER H. BOND	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 1/22/2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15, 18, 19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18, 19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 22, 2008 has been entered.

### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities: Both "controller input interface" and "console input interface" lack antecedent basis. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 1 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicants' limitation of "an audio-visual input interface, coupled to the housing, for receiving input from the local

user to the control circuitry to control audio or video characteristics of an external display", as claimed in applicants' claim 1, and "an audio/video output interface, coupled to the housing, through which the local user provides input associated with control of the television", as claimed in applicants' claim 21, is not reasonably conveyed in the specification. While the Examiner recognizes the applicants' A/V output **113** and A/V interface **230**, disclosed in the specification, reexamination of the specification does not suggest that these parts are capable of performing the limitations listed above.

Moreover, paragraph [0063] of the applicants' specification--that is, "Similarly, the audio/video interface 230 might include a known interface for operating in combination or conjunction with the display device 120, such as for example a direct audio or video output interface. As described above, the integrated console/controller 110 may alternatively or in addition include a speaker or other audio output, so there is no particular requirement for actual audio output to the display device 120," gives no indication that the audio/video interface may be used to control the audio or video characteristics of an external display device. The term 'audio-visual input interface' appears nowhere in the specification. Moreover, A/V is referenced in regards to A/V output 113, and the A/V interface 230--labeled also in Figure 2 as A/V output. While the term 'controller' is a broad term, the broad assertion of 'control inputs' and 'a set of outputs that can be coupled to a display element...', and 'control circuits' are not sufficient to support the audio/visual control which the applicants are trying to claim. Additionally, "the console input interface" is not supported in the applicants' specification.

5. Claims 1 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner recognizes that the broad concept of, "The term 'controller' generally describes any device capable of receiving control inputs...from a user of a console of a game system...and capable of providing a set of outputs that can be coupled to a display element, but given this broad assertion, is unclear how this would support the 'audio-visual input interface' the applicants are claiming, given the lack of reference to a/v control or a/v input in the specification, save for the use of 'control circuitry/circuits'. Additionally, the Examiner is unclear as to the functional integration "the controller input interface and the console input interface", and how this achieved.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-9 and 11-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Sawano et al., USPAT 6,544,126 (Sawano).**

8. As to claim 1, Sawano presents a portable game machine with download capability and discloses (column 5, line 46 - column 6, line 38) that the, "Game system...includes a portable game machine...and a home video game machine...The portable game machine...maybe be, for example, a Nintendo GAME BOY or GAME BOY ADVANCE handheld portable video game system, and the home video game system...may be a...GAME CUBE 3D video game system...the portable handheld unit...and home video game unit...are linked. Connection is provided through a communication cable between a communication port...on a portable game machine...and a communication port...on a video game machine...Other connection means (e.g., RF, infrared, other wireless, etc.) are also possible. The portable game machine...has a game-machine body housing...sized to be held by the hand...The housing...has an LCD (Liquid Crystal Display)...constituting a display disposed on an upper portion of a first surface...thereof...A serial communication port...is provided in a side surface...of the main body. A user manipulated controller interface...is arranged in a lower portion on the front surface...of the housing...The example controller interface...in this embodiment, includes five operation keys....These operation keys...are to be manipulated, typically, by the thumbs or other digits of a game player who is holding the housing....an insertion aperture...is formed in an upper end of a backside...of the main body. In use, the insertion aperture...is used to insert a game memory cartridge...as a first information storage medium. Different games can be played on portable machine...by inserting different cartridges...storing the different game." This would anticipate the applicants' claims of having an integrated console controller

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(portable game machine) comprising: a housing capable of being hand-held, with a location capable of receiving a cartridge, control circuitry (inherent part of machine); a player input interface (controller interface), and a network interface (communication port). Two functions inherent to the GAME BOY which is referenced above in Sawano are a contrast knob for controlling the contrast of the GAME BOY's external LCD display and a volume knob for controlling the volume output to either a speaker or headphones. This would anticipate the applicant's limitation of an audio-visual input interface (contrast and volume knobs) for controlling audio or video characteristics of the external display device (LCD screen).

9. As to claim 2, Sawano discloses (column 7, lines 63-67) that, "The game cartridge...includes a ROM...and a RAM...(e.g., an SRAM). The ROM...stores, for example, a game program or other application. RAM...is available for storing backup data and may be non-volatile (e.g. battery backed)." This would anticipate the applicants' limitation wherein the cartridge includes at least some rewritable memory elements (RAM).

10. Regarding applicants' claims 3, 4, and 6-9, Sawano discloses (column 2, lines 31-41), "When operating in the "download mode", the portable game machine is capable of receiving executable code written to it by a data source (e.g. another portable game machine, a home video game machine, a personal computer, a network, etc.) The portable game machine writes the received executable code into an internal working random access memory and then proceeds to execute the code...this download capability permits multiple players to play a common video game on multiple video

game units using only a single cartridge or other storage media" This anticipates the applicants' limitation further comprising software embodied in a computer-readable medium of the control circuitry that includes at least some elements that have been dynamically replaced or upgraded. This further anticipates the applicants' limitation of a communication interface to at least one general purpose computing device; software including at least one element capable of supporting interactive communication between the integrated controller and the general purpose computing device (i.e. communication between the portable game machines). This further anticipates the applicants' limitation wherein the communication interface includes an input from a substantially remote supplemental console; the communication interface is capable of supporting a dynamic replacement or update of a software element of the software; the software includes at least one element capable of supporting a game with multiple consoles; the software includes at least one element capable of supporting a contest among multiple players, the contest being adjudicated at one of the integrated elements (game machine with cartridge).

11. As to applicants' claim 5, as discussed above and illustrated in Figure 1. of Sawano, the portable game machine and game machine may be linked. Sawano further discloses (column 6, lines 51-54), "The example video game machine...is coupled to an external display...such as a home television set, computer display or the like." This would anticipate the applicants' limitation wherein the communication interface includes an input from a substantially remote output device.



12. As to claims 11, and 13-15, as discussed above, what has been disclosed by Sawano anticipates the applicants' limitation of an integrated console controller including communication interface to at least one supplemental console (game machine), the communication interface being capable of supporting communication between the supplemental console and the integrated console controller (portable game machine); wherein the communication interface includes an input from the supplemental console; further comprising software having at least one element of supporting a game with multiple consoles; further comprising software having at least one element capable of supporting a multiplayer game.

13. As to claim 12, Sawano discloses (column 7, lines 16-21), "An AV (Audio-Video) terminal, not shown, is provided in a rear surface...of the housing...The AV terminal is connected to an AV terminal of a TV monitor...through a cable...It is noted that the AV terminal may, in addition to delivering video signals and audio signals, transmit modulated signal versions of them." This would anticipate the applicants' limitation wherein the communication interface includes a direct audio or video output from the supplemental console to an output device.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**15. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sawano.**

16. As to claim 10, while Sawano discloses software where at least one element supports a multi-player game (contest), Sawano fails to explicitly disclose the limitation, wherein the contest includes a memory having an aggregate measure or a statistical measure of score achieved by multiple players, where each one of the multiple players are associated with an instance of a game. However, Sawano discloses a multi-player game, networking the devices together, and that the portable game machine, the console, other memory containing devices, and the game cartridges used to play the games on Sawano's system all contain RAM (memory). It would have been a matter of choice, well within the capabilities of one skilled in the art to include a memory of an aggregate measure or statistical measure of a scores by multiple players (saving multiple scores to memory over a period of game play), as all the elements to accomplish this are present (multi-player game, memory), and it would have been a function of the game's software--a mere matter of programming.

**17. Claims 18, 19, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawano in view of Innovation's GBA to TV converter (hereinafter Innovation)**

18. As to claims 18, and 21, as discussed above, Sawano discloses a system comprising: a television, a network, a workstation (personal computer) coupled to the network capable of running a contest (game) between users (see Sawano, column 13, lines 15-42), a device associated with the user, coupled to the workstation via the

network; and integrated consoler controller including: a housing with a hand-held form factor having a removable storage interface, wherein, in operation, a removable storage element is coupled to the integrated console controller via the removable storage interface; an interface device coupled to the housing capable of coupling the integrated console controller to the television, the workstation, and a supplemental console (see Sawano, Figure 1); control circuitry coupled to the housing comprising: memory storing software, a secure processor capable of executing or interpreting at least some instructions on the software, a player input interface, through which the user provides input associated with control of the workstation. Sawano does not specifically disclose that the audio and/or video video output interface coupled to the housing, through which the local user provides input associated with control of the television, nor is this claim limitation supported in the applicants' specification.

19. Innovation presents a converter which connects to the portable game system Game Boy Advanced (GBA) disclosed by Sawano (Sawano, column 5, lines 45-52), and (Innovation) discloses, " The GBA TV Converter is split into two parts: a white interface shell that replaces the back of your GBA and a converter pack that connects to your TV. The interface shell links directly to the screen of your GBA and can either mate to the converter pack for TV play, or stand alone and keep the system portable. The whole thing works rather well. The image and sound are transmitted via stereo audio, video or s-video connections. When hooked up, the image shows up on both the TV and GBA screen. While running through to the TV, you have a choice of full screen or smaller to preserve picture quality, which does suffer a little bit by the enlarging process.

Sound, however is awesome. You never knew how good the sound effects and music were on the GBA until you've heard them through actual speakers." Furthermore, looking at the picture of the GBA TV converter, one sees that the video from the headphone jack is directly output to the GBA TV converter interface--containing both stereo and S-video output cables. This would mean that the audio output of the GBA can be controlled via the GBA's volume knob--and inherent part of the GBA--and that the audio output to the television and broadcast on the television could also be controlled via the volume knob. This would meet the applicant's limitation of an audio-visual output interface between the portable device and an external display, through which local user provides input associated with control of the television.

20. Innovation discloses, " Wish your GameBoy Advance were backlit? Yeah, that'd be great. How about a bigger screen, like twenty-seven inches or so? Well, lucky for you some guy over at Innovation thinks like you do, and the result is the GBA TV Converter." The advantage of using such a device is to provide both a bigger and brighter picture for the portable game machine on an external display, and as disclosed above, enhancing the sound.

21. This is evidence that one of ordinary skill in the art would have reason/suggestion/motivation to use TV converter for the purpose of outputting the video and audio of the portable game machine to an external display for a brighter and bigger picture, and enhanced sound.

22. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the portable game machine described by Sawano with

the TV converter described by Innovation for the purpose of outputting the video/audio to an external display for a bigger and brighter picture, and enhanced sound.

23. Sawano further discloses (column 8, line 18 - column 9, line 5), "The...initialize program area...includes an authentication code area...The authentication code area...in this example stores an authentication code such as image data...representative, e.g. of "NINTENDO". The authentication code is preferable encrypted and/or data-compressed...The authentication program stored in an area...of the boot ROM...is a program for carrying out authentication by the utilization of an authentication code provided in the area...the work RAM...of the portable game machine...includes an authentication code area...In the...authentication code area...is stored an authentication code read out of the area...of the...ROM...upon executing the authentication program...The authentication code area...stores, in advance, the predetermined authentication code for comparison with the authentication code stored in the area...of the work RAM...upon executing the authentication program..." Sawano further discloses (column 13, lines 18-24) that, "...another game machine" in the invention may be any game machine to use an information storage medium storing an auxiliary program...including various game machines, such as portable game machines, stand-alone video game machines, personal computers, network connected appliances (i.e. servers), etc." This would further meet the applicants' limitation of a secure processor capable of executing or interpreting at least some instructions in the software, and capable of controlling operation of the software, whereby only authorized software can

be executed or interpreted. This also meet the applicants' limitation further comprising a cartridge that includes at least some information capable of authenticating the software.

24. While Sawano does not explicitly disclose a network server for scoring an online multiplayer game by the user of a hand-held integrated console controller and one or more users, Sawano discloses the use of both servers and multiplayer games play in his invention. Thus, it would have been a matter of choice, well within the capabilities of one skilled in the art at the time the invention was made to use the server described in Sawano--which (the server) has been described as both a game machine and information storage medium--to score an online multiplayer game.

25. As to claims 19 and 22, as previously discussed, Sawano discloses a portable game machine which is capable of downloading and updating existing software. Sawano also discloses, as discussed above (column 7, lines 63-67) that the cartridge includes RAM capable of saving backup data. These both would meet the applicants' limitation further comprising a cartridge that includes at least some information capable of replacing or upgrading the software.

### ***Response to Arguments***

26. Applicant's arguments with respect to claim have been considered but are moot in view of the new ground(s) of rejection.

27. As to the applicant's argument that, "...Sawano does not disclose a player input interface integrated with an audio-visual interface for controlling an external display device...[and] Sawano does not disclose both an audio-visual interface and a network interface to enable a local user to play with a remote user, the Examiner would like to

reiterate that the applicants' specification lacks evidence of "an audio-visual input interface". Evidence of such is found the language used in the applicants' specification regarding audio/visual interfaces/outputs. On page 11 and 12 of the applicants' specification, the applicants state, "The audio/video output 113 is coupled between the integrated console/controller 110 and the display device 120. In one embodiment, the audio/video output 113 is also coupled to the optional power source 130, and includes a power coupling, such as for example an AC adapter usable with an AC power source such as a home power outlet. However, there is no particular requirement that the audio/video output 113 involves a power coupling. In alternative embodiments, power might be supplied to the integrated console/controller 110 by battery storage or another power source. In one embodiment, the audio/video output 113 can communicate a set of audio signals and a set of video signals from the integrated console/controller 110 to the display device 120. However, there is no particular requirement that audio/video output 113 involves any audio signals. In alternative embodiments, audio outputs might be provided directly by the integrated console/controller 110 using a speaker or another audio output device." Nowhere is it suggested that the audio/visual output provides a set of control signals to the external display device for the purpose of controlling the external display, but rather, as understood by those of ordinary skill in the art, provides a set of audio/visual output signals from the game itself for display on the external display or to use the external display for audio output. In keeping with the applicants' initial argument that " The term "controller" generally describes any device capable of receiving control inputs, either directly or indirectly, from a user of a console of a game

system or similar system, and capable of providing a set of outputs that can be coupled to a display element, such as for example a television...," One or ordinary skill in the art would understand control inputs ("coming from the user of a console of game system or similar system") to be controls associated with the game itself. Likewise, the Examiner understands "...providing a set of outputs that can be coupled to a display element..." to be understood as audio/visual output--not control signals. Pages 18 and 19 of the applicants' specification discuss, "...an audio/video interface 230 capable of being coupled to the display device 120...], and continue by stating "...the audio/video interface 230 might include a known interface for operating in combination or conjunction with the display device 120, such as for example a direct audio or video output interface." Again, the Examiner understands the audio/video interface 230 to act as a audio/video output interface, not a control device. Figure 2 of the applicants' specification shows 230 labeled as audio/video output, not control. Here, the applicant suggests through their choice of language in the specification that interface means electrical connector for coupling or linking audio/video output of the console/controller to the television, not controlling it. The Examiner has afforded the applicants the broadest reasonable interpretation of their A/V output and A/V interface 230, but as stated above, fails to recognize where "an audio-visual input interface...to control an audio or video characteristic of an external display device" is supported in their specification.

28. As to the applicants' arguments that Sawano does not read on the applicants' invention because, "In order for a portable game machine to actually be an integrated console controller, it must integrate a controller input interface and a console input



interface", the Examiner argues that the applicants' define their controller input interface on pages 18-19 of the specification as something that is, "...capable of being coupled to the player inputs 112...the controller input interface 220 might include a known interface for operating in combination or conjunction with the player inputs 112." Again, the Examiner concludes that the term interface here has no special meaning (or is this suggested) other than being an electrical connection between the player control buttons (112) and the electrical circuitry of the device. Thus, it would be an inherent part of Sawano's operation to include an interface (electrical connection) between the player inputs and the intrinsic circuitry contained in the device. As to the argument that the Sawano does not integrate a console input interface, the Examiner again, is not finding any mention of "console input interface" or "console interface" in the applicants' specification. In keeping with the Examiner's understanding of an interface used as an electrical connection between two devices, Sawano clearly shows in Figure 1 that connectivity of the portable game system connected to the console game system-- hence, interfaced with one another by means of the connection link (20) and communication port (16) on the portable game device. Thus, both a controller interface and console interface (communication port, control link) are disclosed in Sawano.

29. Applicants' argue that Sawano fails to read on the applicants' invention, as it uses a portable game machine, and have found no mention of an integrated console controller. In claiming an "integrated console controller" (applicants' claim 1), all limitations of what comprises an "integrated console controller" are disclosed by the

portable game system in Sawano. The Examiner fails to see the argument, besides the obvious difference in naming conventions.

30. The applicants' argue that Sawano does not include a network interface and external display. The Examiner argues that Sawano teaches a communication port (16) which is capable of communicating either through a physical link (cable) or by other means including: RF, wireless, etc. (Sawano, column 5, lines 53-59), and Sawano further discloses (column 12, line 66 - column 13, line 55) the possibility of playing a multi-player game by 'communicatably connecting' two or more portable game machines to 'another game machine'--(Sawano, column 13, lines 15-29) which include console game machines, portable game machines, personal computers, **network connected appliances** [emphasis added], etc., and allows for the possibility (Sawano, lines 39-42), "to play the same communication battle game programmed in one cartridge...on all the (e.g. four, in this embodiment) portable game machines..." Previously stated, the LCD display of Sawano's portable game would anticipate the applicants' limitation of an external display device. Thus, the previous rejection is maintained.

31. The applicants' argument that claims 2-15, which depend from claim 1 are allowable because of the alleged allowability of the base claim, are moot in view of the aforementioned rejection.

32. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., player interface through which the user provides input to control the workstation )

are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

33. Sawano, as argued above, clearly presents "a player input interface".

Applicants' also argue that the player interface does not support the a/v output directly to a television, and provides control of the television. While it has already extensively been argued that the applicants' specification does not support the use of such an interface for controlling a television, the Examiner has added an additional reference which teaches both an interface used to connect the portable game machine directly to a television and the ability to control provide input (volume adjustment on portable game machine) to control the volume on the television.

34. Again, in reference that Sawano merely references servers, and that the applicants assert that the Examiner is relying on his/her own information in making the rejection, the Examiner reiterates (Sawano, column 13) the exchange of information between networked devices--with personal computers and networked appliances listed as these devices. While the applicants' have chose to argue one embodiment of Sawano's invention, this is no way limiting, as column 13 clearly discloses that information may be downloaded from a personal computer and networked devices, with these devices acting as the 'master device'. Merriam Webster defines a 'server', as interpreted by the Examiner to be the best fitting definition for the applicants' intention, as "...a computer network that is used to provide services (as access to files or shared peripherals...) to other computers in the network. Sawano fully supports the idea of

playing a networked game via a server. The limitation that the game be scored by the server, as stated above in the rejection, is viewed by the examiner as being an obvious choice well within the capability of one skilled in the art, as the only mention of scoring in the applicants' specification is in regard to a multiplayer-game (page 4) "games can include contests among multiple players for "high score" and the like..." and (page 18), "...the remote server...has the effect that the remote system...can also support a game contest...where each player plays individually, and can be responsive to aggregates or statistical measures of a group of players, such as for example a high score, median score, or an aggregate score... While the broad assertion that 'supporting' a game contest could include saving the multiplayer game scores on a server, it has also been shown that Sawano is also capable of supporting a multi-player contest. Given Sawano illustrates two-way communication between master/slave devices as illustrated in one embodiment of Sawano's invention (Figure 10), and that Sawano lists other devices capable of master/slave relation as personal computers and network appliances, it would have been a matter of choice as to where the aggregate/statistical score information is saved, since the applicants have not pointed out the specific advantage of saving the data specifically to a server, and it appears the functionality of the claimed invention would not be affected if the scores were saved locally, etc. In keeping with Merriam Webster's definition of server, Figure 9 in Sawano, would also be an illustrative example of a server (in this case, the network consisting of the game console and portable game machines), whereby the game machines presumably have control over

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the console, and the console could be used as a storage means for game data such as high scores, etc.

35. As to the argument that claims 18-19, and 22 depend from claim 21, and are allowable based on the alleged allowability of the base claim, the argument is moot in view of the aforementioned argument of claim 21.

36. **The Examiner, when making claims to the inherency of functions/features of brand devices listed in Sawano has included supplemental information to support such inherency claims.**

#### ***Citation of Pertinent Prior Art***

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Siegel, US PUB 2003/0220142--which discloses a controller capable of communicating with a game console and has an external display, with the capability of controlling both audio/visual characteristics of the display and sound output.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER H. BOND whose telephone number is (571)272-9760. The examiner can normally be reached on M-F 9:30am - 6pm (Eastern Standard Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/  
Primary Examiner, Art Unit 3714

/Chris Bond/